

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EDWARD P. DANIELS, JR., ELISSAVET SOUTLOGLOU,
JAMES M. VALOVICH, YUECHENG MENG, KEVIN L. STROBEL,
MICHAEL A. GAGLIARDI, and KEVIN W. BODIE

Appeal 2007-2438
Application 09/862,377
Technology Center 2100

Decided: December 20, 2007

Before JOSEPH F. RUGGIERO, LANCE LEONARD BARRY, and
ST. JOHN COURTENAY, III, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of
claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' claimed invention relates to the locating, obtaining, and
tracking of delivery locations of employees in accordance with a corporate

database system. The location of recipients of messages in a corporation is determined based on a database compilation which includes a recipient's scheduled location, the recipient's delivery preference, and the corporation's preference. (Specification 2-3).

Claim 1 is illustrative of the claims on appeal, and it reads as follows:

1. A method for locating a recipient of a message in a corporation using a computerized system comprising:
 - (a) compiling a database of a recipient's scheduled location, the recipient's delivery preference and the corporation's preference;
 - (b) providing access to recipient's location and delivery preference database of (a);
 - (c) updating the recipient's scheduled location and/or delivery preference; and
 - (d) allowing access to updated schedule and delivery preference to facilitate delivery of message to recipient at updated scheduled location.

The Examiner relies on the following prior art reference to show unpatentability:

Balma	US 6,157,945	Dec. 5, 2000
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Claims 1-10, all of the appealed claims, stand rejected under 35 U.S.C. § 102(e) as being anticipated by Balma.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUE

Under 35 U.S.C. § 102(e), does Balma have a disclosure which anticipates the invention set forth in claims 1-10?

PRINCIPLES OF LAW ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

ANALYSIS

With respect to the 35 U.S.C. § 102(e) rejection of independent claims 1, 5, and 7-10, based on the teachings of Balma, the Examiner indicates (Answer 4-11) how the various limitations are read on the disclosure of Balma. In particular, the Examiner directs attention to the illustrations in Figures 5 and 6 of Balma as well as the accompanying description at column 4, lines 51-61 and column 9, line 29 through column 10, line 7 of Balma.

Appellants' arguments in response assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Balma so as to establish a prima facie case of anticipation. Appellants' arguments at pages 5 and 6 of the Brief and pages 2-4 of the Reply Brief focus on the contention that, in contrast to the claimed invention, Balma does not disclose the compilation of a database which includes corporation preferences, a feature present in all of the independent claims on appeal. According to Appellants, the messaging system disclosed by Balma provides only for user defined message delivery preferences establishing modes of communication which are preferred by a recipient.

After reviewing the disclosure of Balma in light of the arguments of record, we are in general agreement with Appellants' position as stated in the Briefs. Initially, we find no support in the portion of Balma (col. 4, ll. 37-61) cited by the Examiner to support the Examiner's conclusion that the "default conversion" described by Balma can be equated to the claimed "corporate preferences." The cited portion of Balma describes the conversion to a default manner of communication when a specific user's defined delivery preference profile may be incomplete. We agree with Appellants that, at best, this default conversion procedure applies only to a

specific user and would not be interpreted by the skilled artisan as a corporate preference which would apply to all members of a corporation. Further, the Examiner's argument (Answer 13) to the contrary notwithstanding, we find nothing in the cited portion of Balma, or elsewhere in Balma, which discloses the overriding of a user's delivery preferences by corporate rules or preferences.

We also do not agree with the Examiner's attempt (Answer 4 and 12) to equate the description of the Figure 6 flowchart of Balma beginning at column 9, line 29 of Balma with the claimed "corporate preferences." While the Examiner is correct that some of the preferences set forth by Balma in the description of Figure 6 such as when fax transmissions may be made, holiday scheduling of communications, etc. are included as examples of corporate rules and preferences described in Appellants' disclosure, there is no indication that such preferences are considered to be corporate preferences within the context of Balma's disclosure. To the contrary, the Figure 6 flowchart of Balma is specifically directed to the establishment of a user delivery profile which includes delivery preferences defined by a user, not the corporation.

In view of the above discussion, since all of the claim limitations are not present in the disclosure of Balma, we do not sustain the Examiner's 35 U.S.C. § 102(e) rejection of independent claims 1, 5, and 7-10, nor of claims 2-4 and 6 dependent thereon.

CONCLUSION

In summary, we have not sustained the Examiner's 35 U.S.C. § 102(e) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-10 is reversed.

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REVERSED

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